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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/597,943

08/11/2006

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YSAP.PAY.PT3

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7590

03/04/2010

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EXAMINER

QAYYUM, ZESHAN

ART UNIT

PAPER NUMBER

3685

MAIL DATE

DELIVERY MODE

03/04/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/597,943	Applicant(s) MARTINEZ-MIRANDA ET AL.	
	Examiner ZESHAN QAYYUM	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-91 is/are pending in the application.
- 4a) Of the above claim(s) 1-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 48-91 is/are rejected.
- 7) ☒ Claim(s) 53, 76 and 84 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/11/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Claims 48-91 have been examined.
2. Claims 1-47 withdrawn by the Applicant.

Claim Objections

3. Claims 53, 62 and 76 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only "claim 51 and 52", "claim 48 to 61 excepting claim 53", "claim 74 and claim 75". See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Examiner's Comments

4. Applicant's claims are replete with intended use languages. For example claims 48-91 directed to system however these claims also contains intended use ("operable") and therefore are not distinguished from prior art if the prior art has the capability to so perform ((MPEP 2114 and Ex parte Masham, 2 USPQ2d 1647 (1967))).
5. Claims 56-57 and 79-80 using conditional language "if". Therefore, it has been held that language that suggest or makes optional (e.g. if, when) but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP §2106 II C; *In re*

Johnston, 77 USPQ2d 1788 (CA FC 2006); *Intel Corp. v. Int'l Trade Comm'n*, 20 USPQ2d 1161 (Fed. Cir. 1991)).

6. Claims 48-91 state in preamble transfer between dealers and/or customers.

Claims recite most of the places just only dealers. It is unclear to one of the ordinary skill in the art because it should be dealers and/or customer instead of just only dealers.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 65-91 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
8. Claims 65 and 72 recite, "a dealer" and "a telecommunications carrier". The claim invention is directed to nonstatutory subject matter. Therefore, it has been held If the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being, then a rejection under 35 U.S.C. 101 must be made indicating that the claimed invention is directed to nonstatutory subject matter (MPEP §2105).
9. Claims 66-71 and 73-84 are also rejected as each depends from claim 65 and 72 respectively.
10. With respect to claim 85 Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9

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(1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

In this particular case, claim 85 fail prong (1) because the “tie” (e.g. with the mobile phone) is representative of extra-solution activity. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

11. Claims 86-91 are also rejected as each depends from claim 85.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 48-91 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
13. Claim Claims 48, 65 and 72 recite a system including at least one account. It is unclear to one of the ordinary skill because account is not a structural component of a system. The scope of the claims is unclear. (In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989)).
14. Claim 48 recites the limitation "the dealer", "the amount", "each account" and "the receiving dealer" in line 3, 5 and 8 respectively. There is insufficient antecedent basis for this limitation in the claim.
15. Claims 49-64 recite "A system" and "a telecommunication carrier". It is unclear to one of the ordinary skill in the art are these system and telecommunication carrier the same as described in claim 48 or different one? (In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989)).
16. Claim 49 recites the limitation "the receiving dealer's or customer's mobile phone number" in line 3. There is insufficient antecedent basis for this limitation in the claim.

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17. Claim 51 recites the limitation "the amount of the B2B account" in line 3. There is insufficient antecedent basis for this limitation in the claim.
18. Claim 51-53, 63, 74-76, recite "B2B, B2C, and DTMF" respectively. It is unclear to one of the ordinary skill in the art that are these mean business to business or dealer to dealer or dealer to customer or business to customer? (In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989)).
19. Claim 52 recites the limitation "the amount of the B2C account" in line 3. There is insufficient antecedent basis for this limitation in the claim.
20. Claim 53 recites the limitation "the shortcode number" in line 2. There is insufficient antecedent basis for this limitation in the claim.
21. Claim 54 recites the limitation "the dealer" and "their mobile phone" in line 2 and 3 respectively. There is insufficient antecedent basis for this limitation in the claim.
22. Claims 58 and 60 recite "a further communication message". It is unclear to one of the ordinary skill in the art that is this message the same as recited in claim 55 or different one? (In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989)).
23. Claim 59 recites the limitation "the load balance" in line 3. There is insufficient antecedent basis for this limitation in the claim.
24. Claim 62 recites the limitation "the linked account" in line 3. There is insufficient antecedent basis for this limitation in the claim.
25. Claim 67 recite "...load is to be transferred from by means of the destination address the communication message..." it is unclear to one of the ordinary skill is

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this transfer happened by mean of destination address or the communication message or both? (In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989)).

26. Claims 66-71 recite "A dealer". It is unclear to one of the ordinary skill in the art is this dealer the same as described in claim 65 or different one? (In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989)).

27. Claim 69 recite "a communication message" it is unclear to one of the ordinary skill in the art is this message same as recited in claim 65 or different one? (In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989)).

28. Claim 72 recites the limitation "the receiving dealer" in line 7. There is insufficient antecedent basis for this limitation in the claim.

29. The term "as appropriate" in claim 72 is a relative term which renders the claim indefinite. The term "as appropriate" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

30. Claim 74 recite "...facilitating transfer **between dealers**..." it is unclear to one of the ordinary skill in the art that if from claim 72 facilitating transfer of load happened between customers then facilitating transfer between dealer will not occur. (In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989))

31. Claim 75 recite "a dealer" in line 2. It is unclear to one of the ordinary skill in the art that is this dealer same as recited is claim 72 or different one? (In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989))

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32. Claim 76 recites the limitation "the shortcode" in line 3. There is insufficient antecedent basis for this limitation in the claim.
33. Claim 79 recite "match a communicated PIN or password". It is unclear to one of the ordinary skill in the art because PIN or password never communicated before. (In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989))
34. Claim 85 recites the limitation "the unique identifier" and "the amount" in line 4. There is insufficient antecedent basis for this limitation in the claim.
35. Claims 86-91 recite "A method" and "a telecommunication carrier". It is unclear to one of the ordinary skill in the art are these method and telecommunication carrier the same as described in claim 85 or different one? (In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989))
36. Claim 91 recite "the payer" in line 4. There is insufficient antecedent basis for this limitation in the claim.
37. Claims 49-64, 66-71, 73-84 and 86-91 are also rejected as each depends from claim 48, 65, 72 and 85 respectively.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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38. Claim 48-52, 54-63, 65-67, 69-75 and 77-91 are rejected under 35 U.S.C. 102(b) as being anticipated by Ranjan (US 20020029193).

39. With respect to claims 48, 51-52, 65, 72, 74-75 and 85, Ranjan discloses: receiving a communications message from a dealer (i.e. first user/payor) at a destination address (See abstract, paragraph 0009-0011) ascertaining the unique identifier of the receiving dealer (i.e. second user/payee) or customer and the amount to be transferred from either the communication message and/or the destination address (See paragraph 0009-0011, 0038, 0040-0042) transferring load from at least one account associated with a mobile phone possessed by the dealer equal to the amount to be transferred to the customer (See paragraph 0038, 0047 and 0048).

40. With respect to claims 49 and 73, Ranjan discloses all the limitations as described above. Ranjan further discloses: where the destination address is a telephone number comprising a set shortcode number and the receiving dealer's or customer's mobile phone number (See paragraph 0027 and 0041-0042).

41. With respect to claims 50 and 66, Ranjan discloses all the limitations as described above. Ranjan further discloses: where the receiving dealer or customer makes payment for the transfer of load either in legal tender or electronically (See paragraph 0038, 0047 and 0048).

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42. With respect to claims 54, 77 and 87 Ranjan discloses all the limitations as described above. Ranjan further discloses: where the dealer configures their mobile phone (See paragraph 0039, 0046-0048)

43. With respect to claims 55, 57, 69, 71, 78 and 81, Ranjan discloses all the limitations as described above. Ranjan further discloses: where the dealer is requested to confirm that the transfer is to proceed by means of a further communication message, the dealer thereafter operable to send a confirmation communication message (See paragraph 0047-0048 and 0050).

44. With respect to claims 56, 70, 79, 88 and 91 Ranjan discloses all the limitations as described above. Ranjan further discloses: where the confirmation communication message includes a PIN or password and confirmation occurs if the communicated PIN or password matches a pre-stored PIN or password for the dealer (See paragraph 0039).

45. With respect to claims 58, 60, 81 and 82, Ranjan discloses all the limitations as described above. Ranjan further discloses: where a further communication message is sent to the dealer on effecting the transfer (See paragraph 0048).

46. With respect to claims 59 and 90, Ranjan discloses all the limitations as described above. Ranjan further discloses: where the further communication

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message includes details of the load balance credited to the dealer after effecting the transfer (See paragraph 0038, 0048).

47. With respect to claims 61, 83 and 89 Ranjan discloses all the limitations as described above. Ranjan further discloses: where each transfer is given a trace number to facilitate reconciliation and auditing (See paragraph 0051).

48. With respect to claims 62, 67, 84 and 86, Ranjan discloses all the limitations as described above. Ranjan further discloses: where the dealer identifies which of the linked accounts load is to be transferred from (See paragraph 0040).

49. With respect to claim 63, Ranjan discloses all the limitations as described above. Ranjan further discloses: where the communication messages take at least one of the following forms: Short Messaging Service message; e-mail; telephone call utilizing DTMF signals; written communication sent by post; verbal communication (See paragraph 0048).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

50. Claims 53, 64, and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ranjan (US 20020029193).

51. With respect to claims 53 and 76, Ranjan discloses all the limitations as described above. With respect to “where the shortcode number used to effect the transfer determines whether the transfer is to be made from the B2B account or the B2C account” these are nonfunctional descriptive material because it just describe the data stored in the memory. Therefore, it has been held nonfunctional descriptive material will not distinguish the invention from prior art in term of patentability (In re Gulack, 217 USPQ 401 (Fed. Cir. 1983), In re Ngai, 70 USPQ2d (Fed. Cir. 2004), In re Lowry, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II).

52. With respect to claim 64, Ranjan discloses all the limitations as described above. Ranjan discloses communication message. Ranjan does not explicitly disclose: communication message is encrypted. The Examiner takes Official Notice that encrypting a message is old and well known in the art. Therefore, it would have been obvious to encrypt message in order to provide security.

53. Claim 68 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ranjan (US 20020029193) in view of Sheth (US 20020194502).

54. With respect to claim 68, Ranjan discloses all the limitations as described above. Ranjan does not explicitly disclose: setting password protection preventing use of

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the mobile phone. Sheth discloses: setting password protection preventing use of the mobile phone (See paragraph 0094). Therefore, it would have been obvious to one of the ordinary skill in the art at the time invention was made to modify Ranjan reference with Sheth reference in order to provide security.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Herlin (US 6023689) discloses: Method for secure communication in a telecommunications system.
- Kwan (US 20020147685) discloses: Computer Network method for conducting payment over network.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ZESHAN QAYYUM whose telephone number is (571)270-3323. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Z. Q./

Examiner, Art Unit 3685

/Calvin L Hewitt II/

Supervisory Patent Examiner, Art Unit 3685